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### Remarks/Arguments

#### 1. Introduction

Claims 18, 22, 28, 32-55 are currently pending in the application. Claims 34-38, 44-55 are amended herein to clarify the claim language. All amended claims are fully supported by the specification such that no new matter has been added for prosecution. For at least the reasons stated below, Applicant asserts that all claims are now in condition for allowance, and respectfully requests that the present rejections be withdrawn and a notice of allowance be issued.

#### 2. Claim Rejections Pursuant to 35 U.S.C. § 112

Claims 18, 22, 28, and 32-55 are rejected pursuant to 35 U.S.C. § 112 ¶ 1 for allegedly failing to comply with the written description requirement. Specifically, claims 18, 22, 28, and 32-55 include the term "supply chain environment manager" which is asserted to appear to be defined in the specification. It is apparent from the context of the specification that the concept of a supply chain environment manager is defined such that one skilled in the relevant art would understand the meaning of the phrase. Applicant respectfully references page 25 of the specification under the heading "e-supply chain model", second paragraph beginning "in more detail, the present invention manages the supply chain between the manufacture(s) and service provider(s)." According to the disclosure, specific components "manage end-to-end supply chain information" applicable to an industry supply chain among manufacturers and service providers. The components that operate to manage the supply chain are then defined in exemplary fashion. From this language, it is clear that a supply chain environment manager is described sufficiently to demonstrate possession of the claimed invention, and, furthermore, that the manager is in fact software. ("The industry supply and management is centralized in an e-commerce market space 206, which includes components that manage end-to-end supply chain information.") Based on this language, the concept of a supply chain environment manager is sufficiently demonstrated such that the requirements of 35 U.S.C. § 112 ¶ 1 are satisfied, and rejection is inappropriate.

In addition, claims 18, 22, 28, and 32-55 are rejected under 35 U.S.C. § 112 ¶ 1 for the alleged combination of disparate elements. To begin, Applicant clarifies that claims 38, 44, and 50 are not, and should not, be rejected pursuant to 35 U.S.C. § 112 ¶ 1 because such claims are fully disclosed at pages 46-47 of the Specification and in figure 11. As to

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their combination with the remaining claims 18, 22, 28, 32-37, 39-43, 45-49, and 51-55, while language beginning at page 435 and figure 104 of the specification are spatially remote from language discussing the basic e-supply chain model and maintenance and service and functionality, discussed in principle, of that e-supply chain at page 43, it is inappropriate to interpret such elements as being unrelated. Specifically under the heading "Maintenance and Administration 9008", the text of the specification begins "Figure 104 illustrates a flowchart for a method for administering an e-commerce system on a network." (Specification at 439). At page 43 under the heading "Maintenance and Service 216", the language begins "Figure 11 illustrates a flowchart for a methodology for providing maintenance and service in a network based supply chain." (Specification at 43). This network based supply chain is part of an e-supply chain model, as disclosed at page 25. Moreover, one of ordinary skill in the art would understand an e-commerce supply chain functions by necessity on a network. These sections of the specification when read together indicate that the later section regarding maintenance administration applies to the e-commerce system of the network based supply chain disclosed earlier. Moreover, the section beginning at p. 435 defines operations the methodology contemplate that is presented earlier. While language in this section discusses updating information at predetermined intervals, such predetermined intervals may well be determined by notices sent by either manufacturers or service providers to recommend or to request service. Additionally, it would be an obvious extension that such maintenance could also be extended on a non-predetermined interval such as by request or recommendation of a user of the e-commerce system. Additionally while information and operational components may be monitored, as noted, such monitoring does not foreclose automatization of those same components, as again, to an ordinary person skilled in the art, optimization of the system would be part of maintenance of that same system. Clearly, however, irrespective of words used in the paragraph describing maintenance and administration of the e-commerce system, this clearly discloses functions that could and would be performed in maintaining the e-commerce system. Because the limitations disclaimed are described in the Specification, the requirements of 35 U.S.C. § 112 ¶ 1 are satisfied and rejection is inappropriate.

For the foregoing reasons, by either argument or amendment, the rejections of claims 18, 22, 28, and 32-55 under 35 U.S.C. § 112 have been traversed, and Applicant respectfully requests the withdrawal of such rejections.

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### **3. Claim Rejections Pursuant to 35 U.S.C. § 112 ¶ 2**

Claims 18, 22, 28, and 32-55 are rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to point out particular and distinctive claim subject matter relating to the term "supply chain environment manager". As addressed in section 2, *supra*, Applicant referenced specific portions of the Specification defining a framework manager. In light of the above-referenced discussion, the requirements of 35 U.S.C. § 112 ¶ 2 are satisfied and rejection inappropriate. Claim 33 has been rejected based on a lack of antecedent basis for the claim limitation "indexed according to each framework user's profile". The claim has been amended to correct this deficiency and Applicant respectfully requests the withdrawal of this rejection.

Claims 22, 34-35, and 44-49 are rejected pursuant to 35 U.S.C. § 112 ¶ 2 as allegedly constituting software *per se*. These claims are amended in the present amendment and Applicant respectfully requests the withdrawal of this rejection.

For the foregoing reasons, by either argument or amendment, the rejections of claims 18, 22, 28, and 32-55 under 35 U.S.C. § 112 have been traversed, and Applicant respectfully requests the withdrawal of such rejections.

### **4. Claim Rejections Pursuant to 35 U.S.C. § 101**

Claims 18, 22, 28, 32-55 are rejected under 35 U.S.C. § 101 on the basis that the claimed invention is directed to non-statutory subject matter. Applicant respectfully disagrees with this rejection in the assessment of the invention by the Examiner.

Claims 18, 32-33, and 38-43 are alleged to not be within the technological arts because it does not appear that the steps "specifically require the use of any technology to be performed". This assessment was based on the conclusion that the e-commerce supply chain environment manager is a person. Office Action, at 6. As noted by the Supreme Court, the language of 35 U.S.C. § 101 provides that a patent may be obtained on "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09 (1980); see also MPEP § 2106(iv)(A). As such, computer related processes are statutorily acceptable if limited to a practical application in the technological arts. In that regard, because it has been demonstrated that the e-commerce supply chain environment manager is a compilation of programmable modules rather than an individual person which then function to perform maintenance and service through scheduling prompted by requests

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and advisements from supply chain participants, such type of invention falls within the safe harbor of § 101 in that it is a computer related process limited to a practical application in the technological arts. MPEP § 2106.

Claims 22, 24-25, and 44-49 are alleged to be software *per se*. (Office Action at 7). Claims 22, 24-25, and 44-49 have been amended to traverse this rejection.

Claims 26-37 and 50-55 are rejected under 35 U.S.C. § 101 on the basis that "a collection of code segments is software *per se*, which is non-statutory subject matter." Office Action, at 7. Applicant has amended claims 26-37 and 50-55 to remove the phrase "executable on a computer" such that the language claims "a computer program embodied on a computer readable medium," which is language considered to fulfill the statutory requirements of 35 U.S.C. § 101. MPEP § 2106(N)(P)(1)(a).

For the foregoing reasons, by either argument or amendment, the rejections of claims 18, 22, 28, and 32-55 under 35 U.S.C. § 101 have been traversed, and Applicant respectfully requests the withdrawal of such rejections.

#### **5. Claim Rejections Pursuant to 35 U.S.C. § 102**

Claims 18, 22, 28, 32-38, 40-44, 46-50, and 52-55 are rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by *Sekizawa*, U.S. Patent No. 6,430,711 (hereinafter "*Sekizawa*"). Applicant respectfully disagrees with the propounded rejection and asserts that *Sekizawa* fails to anticipate multiple elements of claims 38, 44, and 50 as presently amended.

*Sekizawa* fails to anticipate the claim limitation of an e-commerce environment manager managing the e-commerce environment as disclosed. In rejecting the claims, no patentable weight was accorded to the preamble. (Office Action at 13). "[Determining] whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case." MPEP § 2111.02. "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." MPEP § 2111.02 (citing *Pitney Bowes, Inc. v. Hewlett Packard Co.*, 182 F.3d 1298, 1305, 51 U.S.P.Q.2d 1161, 1165-66 (Fed. Cir. 1999)). For example, in *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (C.C.P.A. 1951) the court held that the phrase "an abrasive article" appearing in the preamble was considered essential to

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point out the claimed invention to an article comprising abrasive grains in a hardened binder and the processing of making it. The court held that it was by that phrase that it would know what the subject matter defined by the claims is comprised. Similarly, in the present application, the phrase "e-commerce supply chain environment manager" is a necessary element to define the substance of the claimed invention contained in subparagraphs (a) through (e). Without knowledge of this phrase it is not clear in the body of the claim what is being modified. *See also Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 U.S.P.Q.2d 1154, 1158 (Fed. Cir. 2003) (in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather a statement of the intentional purpose for which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia.)

Considering claim 38<sup>1</sup> in light of patentable weight afforded to the preamble, *Sekizawa* fails to disclose or suggest application of a manager of the e-commerce supply chain environment that performs maintenance activities on the e-commerce supply chain environment.<sup>2</sup> *Sekizawa* Figure 1 illustrates the communication channels between the console unit 20, the agent units 10, and the mail server 19. Clearly from this arrangement, information is transferred unidirectionally, from the plurality of agent units 10 through the mail server 19, and on to the console unit 20. *See* Fig. 1; col. 19, ll. 15-35 (describing interaction between the separate computer platforms). Clear from the disclosure in *Sekizawa* is that the central routing computer, the mail server 19, *acts as a conduit through which information is passed unidirectionally*, and arguably, although not conceded, bidirectionally. Mail server 19, however, fails to perform any maintenance or other service of the network; it solely acts as a compiling station of email information sent on to the console unit 20. This limited activity distinguishes it from the present invention, and fails to teach or suggest the limitations described in the present claims.

In comparison, the present invention discloses an e-commerce supply chain environment in which a manager of the environment operates to perform maintenance on

<sup>1</sup> Claim 38 is considered exemplary of claims 44 and 50.

<sup>2</sup> The following two paragraphs have been previously presented in the paper filed July 1, 2005, and are equally applicable now in light of the cursory consideration because of the failure to consider the entire claim, including the preamble.

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the environment. Drawing 2 discloses an e-commerce environment in which transactions are performed independent of any system maintained by any user of the e-commerce supply chain system. As part of the functionality of the e-commerce environment, a separate manager of the e-commerce supply chain environment exists that, in part, performs maintenance and service 216 of the environment, as depicted in Drawing 6. This distinction is claimed in not only the preamble (claiming a method, system, and computer program that provides functionality for an e-commerce supply chain environment manager) but also parts (a) and (b) of the independent claims in which users of the e-commerce supply chain environment submit information to the environment manager on which the manager may act. See claims 38, 44, and 50. Upon receipt of such information from users of the system, the environment manager performs activities and transmits information back to the users. See *id.* This activity by the environment manager clearly distinguishes the claimed invention from *Sekizawa*, in which the neither the counsel unit 20 nor mail server 19 act in such a capacity.

Because *Sekizawa* fails to disclose the operation of the e-commerce supply chain manager, rejection pursuant to 35 U.S.C. § 102(e) is inappropriate, and Applicant respectfully requests the withdrawal of such rejection.

In addition, *Sekizawa* fails to disclose several other claim limitations. Specifically, in light of the fact that *Sekizawa* fails to contemplate an independent supply chain manager unassociated to the provider and consumer users, as discussed in the preceding paragraphs, *Sekizawa* fails to disclose claim limitation (a). The citations to *Sekizawa*, 2:50-67; 3:1-23; 4:50-65; 5:40-50; and 6:55-65; all disclose the receipt of system status information from individual network printers (local monitor unit) which are users of the system. These citations wholly fail to disclose receiving recommendations for maintenance and service, nonetheless receiving such notifications from a provider.

Moreover, there is an apparent inconsistency between the rejection and reasoning applying *Sekizawa* because the same citations are relied upon to reject limitation (b), in which the supply chain manager receives *requests* for maintenance, obviously different from the *recommendations* received as defined in limitation (a). The citations are arguably, but not concededly, applicable to anticipate claim element (b) because the transmissions originate from client users which transmit status potentially indicating maintenance is required. Such citations could not also be applicable to reject limitation (a).

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In addition, element (c) relating to the scheduling of service is not anticipated. The *Sekizawa* citations disclose the receipt of status to a system operator who potentially dispatches a service technician.<sup>3</sup> See *Sekizawa* at 4:50-65; 5:40-50; 6:55-65; and 7:56-8:36. The language of these citations fails to mention any form of schedule performed.

Consequently, without scheduling being performed, *Sekizawa* also fails to anticipate element (d), in which the schedule for maintenance and service is transmitted. The citations propounded to support the rejection, figure 28; 2:50-67; 3:1-28; 4:50-65; 5:40-60; 6:55-65; 7:59-67; and 8:1-36, fail to support transmission of a schedule for performing maintenance. Instead, these citations describe the dispatch of maintenance personnel. Moreover, it is unclear that *Sekizawa* can anticipate this element because the schedule is not transmitted from a supply chain environment manager independent of the participant. In *Sekizawa*, the monitoring unit claimed to be representative of the supply chain environment manager is not independent from the participants of the supply chain. See Figure 1 (noting all status mail routed to 20 without bidirection access or control).

Finally, *Sekizawa* fails to anticipate element (e) because, simply, the purported supply chain environment manager in *Sekizawa* does not perform the scheduled maintenance and service. In the citations provided, other entities perform such maintenance, and such maintenance and service is not to the environment, but *independent users* of the environment. See *Sekizawa* at 4:5-25; 4:40-62; 7:35-50; and 8:1-7. The remaining citations that disclose the performance of maintenance, are irrelevant because they do not relate to maintenance of the system environment.

Applicant submits that the rejection of dependent claims 18, 22, 28, 32-37, 39-43, 45-49, and 51-55 are in condition for allowance because independent claims 38, 44, and 50 fail to disclose all elements of the claimed invention; hence, such dependent claims are also not disclosed.

For the foregoing reasons, by either argument or amendment, the rejections of claims 18, 22, 28, and 32-55 under 35 U.S.C. § 102(c) have been traversed, and Applicant respectfully requests the withdrawal of such rejections.

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<sup>3</sup> Some citations however, fail to even colorably support the rejection. See *Sekizawa* 2:50-3:25 (discussing transmission of information to system manager).

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**6. Claim Rejections Pursuant to 35 U.S.C. § 103(a)**

Claims 39, 45, and 51 are rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over *Sekizawa*, U.S. Patent No. 6,430,711, and *Haluska*, U.S. Patent No. 5,638,519. Because claims 39, 45, and 51 depend from claims 38, 44, and 50 which have been shown to be patentable over the cited prior art, the additional limitation cited in claims 39, 45, and 51 is not rendered obvious by the cited prior art because claims 39, 45, and 51 have not been shown to be obvious modifications of the prior art. For that reason, Applicant respectfully requests the withdrawal of the rejection pursuant to 35 U.S.C. § 103(a) and that a notice of allowance be issued.

**7. Conclusion**

Applicant submits that for at least the reasons stated above, all pending claims are allowable over the art of record and respectfully requests reconsideration and that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7263. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-336701).

Respectfully submitted,



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